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09/990,987	11/21/2001	Risto Kivipuro	460-010723-US(PAR)	3443

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 April 2010</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-11, 13 -14, 16, 18, 20, 24 and 33-42, 44-48</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-11, 13 -14, 16, 18, 20, 24 and 33-42, 44-48</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Applicants' amendment filed on April 9, 2010 is hereby acknowledged. Accordingly,

claims 2-11, 13 -14, 16, 18, 20, 24 and 33-42, 44-48 remain pending. A request for

continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on April 9, 2010 has been

entered.

Response to Arguments

2.   The Applicant states that there is nothing in Kadyk which would disclose or suggest:

supplementing said at least one device specific content component with at least one data

structure that describes system attributes needed to run the at least one device specific

content component and provides information identifying the content.

The Examiner responds that Kadyk discloses providing error free content to a mobile

platform, The Examiner submits that the network device in Kadyk would have a unique

network address and that information sent to the device would include the mobile

device's unique network address in he content's routing information. (Column 8, lines 54-

67), the Examiner submits that any packets address to the mobile device would be

"device specific" via unique network address. The Examiner further submits that the

content of the data structure (e.g. that describes system attributes needed to run the at

least one device specific content component and provides information identifying the

content) is directed towards non-functional descriptive material. (MPEP 2106 II; *In re*

Gulack, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai,* 70 USPQ2d (Fed. Cir. 2004), *In re*

Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate

Applicant's device from the prior art).

The Applicant states that Sherer fails to disclose examining the data structure of the

device specific content packet to identify download properties of the device specific

content packet and compatibility of the at least one device specific content component

with the particular wireless device;

The Examiner states that Sherer discloses identifying what type of microprocessor (e.g.

specific device) exists in a system and the selecting portions of programming code that

are specifically used with the identified microprocessor, the Examiner submiots that this

therefore teaches the claimed limitation see Column 4, lines 55 – column 5, line 25, lines

32-65; column 29, lines 12-28.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

3.   Claims 2-14 and 33-42 are rejected under 35 U.S.C. §101 because the claimed invention

is directed to non-statutory subject matter.

4.   Based on Supreme Court precedent (See also *Diamyees ond v. Diehr*, 450 U.S. 175, 184

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S.

63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal

Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. In addition, the tie to a particular apparatus, for

example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed.

Cir. 2008).

An example of a method claim that would not qualify as a statutory process would

be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory

class (the thing or product) to which it is tied.   This may be accomplished by having the

claim positively recite the machine that accomplishes the method steps. Alternatively or

to meet prong (2), the method step should positively recite identifying the material that is

being changed to a different state or positively recite the subject matter that is being

transformed.

In this particular case, claim 33 fails prong <u>(1) because the method steps are not tied to a

machine and can be performed without the use of a particular machine.</u> Additionally, the

claim(s) fail prong (2) because the method steps do not transform the underlying subject

matter to a different state or thing. Examiner further notes that Claim 33 is non-statutory

subject matter because the only claimed feature in the claim is "using a content server"

which is directed towards an abstract process. (what the database is configured for is

directed towards non-functional descriptive material.).

5.   Claims 2-14, and 34-35 are either dependant upon claim 33 or contain similar

limitations and rejected for at least the same reason.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

6.   Claim 44 is rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

This claim recites the following means plus function limitation: "means for selecting the

content packet; means for examining the data structure of the content packet;

means for compiling the content packet for; means for selecting one or more of the at

least one device specific content component in the downloaded content packet for

activation; and means for activating the selected at least one device specific content

component in the particular wireless device.

These claim limitations begin with a term followed by functional language and the term

is not modified by sufficient structure or material for performing the claimed function.

Furthermore, the specification does not provide a description sufficient to inform one of

ordinary skill in the art the meaning of the term; and the term is not an art-recognized

structure to perform the claimed function. Accordingly, the limitation invokes 35 USC §

112, ¶ 6.

35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding

structure, material, or acts described in the specification and equivalents thereof. "If one

employs means plus function language in a claim, one must set forth in the specification

an adequate disclosure showing what is meant by that language. If an applicant fails to

set forth an adequate disclosure, the applicant has in effect failed to particularly point out

and distinctly claim the invention as required by the second paragraph of section § 112."

In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in

banc.).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102
of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

8.   Claims 2-11, 13 -14, 16, 18, 20, 24 and 33-42, 44-48 are rejected under 35 U.S.C. §103

as being unpatentable over Kadyk et al (6,209,111) in view of Graunke et al (5,991,399)

and further in view Ginter et al (U.S. 5,892,900) and further in view of Sherer et al. (US

Patent 5,459,854).

9.   Regarding claim 33- 35, 43-44 and 46

Kadyk et al   discloses a method for providing contents for a wireless communication

device said wireless communications device comprising at least means for utilizing the

content, the method comprises:

using a content packet loading server and a content database, wherein the content packet

loading server with the content database is configured for:

forming at least one device specific content packet <u>as a single file specifically for the</u>

<u>particular wireless device</u> from the at least one device specific content component

supplemented with the first data structure.(Column 8, lines 54-67; Column 11, lines 55-

63 – messages are merged) a <u>second</u> data structure that describes a content of the device

specific content packet and provides information required by the wireless communication

device to run the at least one device specific content component storing said device

specific content packet; and selecting at least one device specific content component

which said examining indicated is compatible with the particular wireless device;

(Column 11, lines 5-42)

loading said device specific content packet into said wireless communication device after

determining from the <u>second</u> data structure a compatibility of the at least one device

specific content component with the wireless device. (Column 11, lines 55-63) .

The differences between the above and the claimed invention is the use of explicit data

structure definition. It is noted that the claim appears to read on all wireless packets with

headers. It is further noted that metadata describes or defines other data and is normally

present as a constituent of complex header data. Each of Ginter et al (See Figs 5b, 17, 20,

26-30, Col. 284, lines 15- 40) or Watanabe et al (See Fig. 5-7, 11-12 and claims 1-11)

show packets with complex headers in a wireless environment including metadata. It

would have been obvious to the person having ordinary skill in this art to provide a

similar arrangement for Kadyk et al because packet

Kadyk et al does not explicitly disclose forming at least one device specific content

component from the content; supplementing said at least one device specific content

component with a first data structure that includes information related to charging for use

of the at least one device specific content component, describes system attributes needed

to run the at least one device specific content component, and provides information

identifying the content. Graunke et al. ('399) discloses forming at least one device

specific content component from the content; supplementing said at least one device

specific content component with a first data structure that includes information related to

charging for use of the at least one device specific content component, describes system

attributes needed to run the at least one device specific content component, and provides

information identifying the content; (column 3, line 52 –column 4, line 7) It would be

obvious to one having ordinary skill in the art at the time of the invention to combine

Kadyk et al method with Graunke et al. ('399)'s teaching in order to allow the consumer

download authenticated copies of electronic media.

Kadyk et al does not explicitly disclose examining the data structure of the device

specific content packet and identifying download properties of the at least one device

specific content packet and compatibility of the at least one device specific content

component with the particular wireless device; Sherer et al. ('854) discloses examining

the data structure of the device specific content packet and identifying download

properties of the at least one device specific content packet and compatibility of the at least one device specific content component with the particular wireless device; (Column 4, lines 55 – column 5, line 25, lines 32-65; column 29, lines 12-28).   It would be obvious to one having ordinary skill in the art at the time of the invention to combine Kadyk et al method with Sherer et al.'s teaching in order to allow the consumer download authenticated copies of electronic media.

The differences between the above and the claimed invention is the use of explicit data structure definition. It is noted that the claim appears to read on all wireless packets with headers. It is further noted that metadata describes or defines other data and is normally present as a constituent of complex header data. Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15- 40) show packets with complex headers in a wireless environment including metadata. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Kadyk et al because packet header are the functional equivalent of the claim limitations.

In regard to claims 33 and 35 Examiner notes that what the database is configured for e.g. "forming at least one device specific content component from the content; supplementing said at least one device specific content component with a first data structure that includes information related to charging for use of the at least one device specific content component, describes system attributes needed to run ihe at least one device specific content component, and provides information identifying the content; examining the data structure of the device specific content packet and identifying download properties of the at least one device specific content packet and compatibility of the at least one device

specific content component with the particular wireless device; selecting at least one

device specific content component which said examining indicated is compatible with the

particular wireless device; forming at least one device specific content packet as a single

file specifically for the particular wireless device from the at least one device specific

content component supplemented with the first data structure and a second data structure

that describes a content of the device specific content packet and provides information

required by the wireless communication device to run the at least one device specific

content component; storing said device specific content packet; and loading said device

specific content packet into said wireless communication device after determining from

the second data structure a compatibility of the at least one device specific content

component with the wireless device." is representative of non-functional descriptive

material as the electronic document is not functionally related to the display device

(MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai,* 70 USPQ2d

(Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be

used to differentiate Applicant's device from the prior art).

In regard to claim 46 Examiner notes that the manner in which a claimed apparatus is

intended to be used (e.g determining a property… selecting a device-specific content etc.

) does not distinguish the claimed apparatus from the prior art- if the prior art has the

capability to so perform(MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

The Examiner notes that if the claim were amended to executing the instructions stored

the memory the claimed limitations would have patentable merit eg.. "processor; memory

storing executable instructions that when executed by the processor cause the processor

to perform the steps of:"

10. Regarding the data limitations of claim 2, Ginter et al (See Figs 5b, 17, 20, 26-30) show

packets with complex headers in a wireless environment that are conventional functional

equivalents of the claim limitations.

11. Official Notice is taken that "a device specific content packet" is common and well

known in prior art in reference to network protocols. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to utilize a device

specific content packet in order to authenticate the client device. The Examiner notes

that this feature is commonly used by any system utilizing a network with a digitally

signed, commonly used in secure networks and content distribution systems. See *e.g.*

Yianolos.

12. Regarding server limitations of claim 3, Kaydyk et al (See elements 12 or 16) disclose

web server equivalents that are conventional functional equivalent of the claim

limitations.

13. Regarding storage limitations of claim 4, Kaydyk et al (See elements 59 and 61) disclose

storage that is conventional functional equivalent of the claim limitations.

14. Regarding the separate storage limitations of claim 5, Kaydyk et al (See Figs. 7 and 11,

Col. 1, lines 45-65, Col. 9, lines 50-65,) disclose a method for associating content with a

separate data structure (header) in a wireless communication device that are conventional

functional equivalents of the claim limitations.

15. Regarding definition limitations of claim 6, Ginter et al (See Figs 5b, 17, 20, 26-30) show

content definition within a complex packet header that is conventional functional

equivalent of the claim limitations.

16. Regarding charge limitations of claim 7, Ginter et al (See Figs 5b, 17, 20, 26-30) show

content definition within a complex packet header that includes usage charge that is

conventional functional equivalent of the claim limitations.

17. Regarding protection limitations of claim 8, Ginter et al (See Figs 5b, 17, 20, 26-30)

show content definition within a complex packet header that includes copy protection that

is conventional functional equivalent of the claim limitations.

18. Regarding the encryption limitations of claim 9, Ginter et al (See Figs 5b, 17, 20, 26-30)

show content definition within a complex packet header that includes encryption that are

conventional functional equivalents of the claim limitations.

19. Regarding content limitations of claim 10, Ginter et al (See Figs 5b, 17, 20, 26- 30) show

multimedia content definition within a complex packet header that is conventional

functional equivalent of the claim limitations.

20. Regarding executable limitations of claims 11, 46 and 47 Ginter et al (See Figs 5b, 17,

20, 26-30) show content definition within a complex packet-header that includes

executable code that is conventional functional equivalent of the claim limitations.

21. Regarding classification limitations of claim 13 Ginter et. al. (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes multimedia data classified by type that is conventional functional equivalent of the claim limitations.

22. Regarding information limitations of claim 14, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes new data that is conventional functional equivalent of the claim limitations.

23. Regarding the data limitations of claim 16, Ginter et al (See Figs 5b, 17, 20, 26- 30) or Watanabe et al (See Fig. 5-7, 11-12 and claims 1-11) show packets with complex headers in a wireless environment that are conventional functional equivalents of the claim limitations.

24. Regarding the separate storage limitations of claim 18, Kaydyk et al (See Figs. 7 and 11, Col. i, lines 45-65, Col. 9, lines 50- 65,) disclose a method for associating content with a separate data structure (header) in a wireless communication device that are conventional functional equivalents of the claim limitations.

25. Regarding definition limitations of claim 20, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that is conventional functional equivalent of the claim limitations.

26. Regarding classification limitations of claim 24 Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes multimedia data classified by type that is conventional functional equivalent of the claim limitations.

27. Regarding searching limitations of claim 25, Ginter et al (See Figs 5b, 17, 20, 26-30)
show content definition within a complex packet header that includes pointers that is
conventional functional equivalent of the claim limitations.

28. Regarding selection limitations of claim 36, Ginter et al (See Figs 5b, 17, 20, 26-30, Col.
284, lines 15-40) show content definition within a complex packet header that includes
metadata and multimedia data classified by type that is conventional functional
equivalent of the claim limitations.

29. Regarding content limitations of claims 37-42, Ginter et al (See Figs 5b, 17, 20, 26-30,
Col. 284, lines 15-40) show content definition within a complex packet header that
includes metadata, content descriptors, and multimedia data classified by type that is
conventional functional equivalent of the claim limitations.

30. Regarding claim 43, Kaydyk et al (See Figs. 7 and 11, Col. 1, lines 45-65, Col. 9, lines
50-65,) disclose a means for associating content with a data structure (header) in a
wireless communication device substantially as claimed. The differences between the
above and the claimed invention is the use of explicit data structure definition. It is noted
that the claim appears to read on all wireless packets with headers. It is further noted that
metadata describes or defines other data and is normally present as a constituent of
complex header data. Each of Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-
40) or Watanabe et al (See Fig. 5-7, 11-12 and claims i-ii) show packets with complex
headers in a wireless environment including metadata. It would have been obvious to the
person having ordinary skill in this art to provide a similar arrangement for Kaydyk et al
because packet headers are conventional functional equivalents of the claim limitations.

31. Regarding claim 44, Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) show content definition within a complex packet header that includes metadata and multimedia data classified by type that is conventional functional equivalent of the claim limitations.

32. Regarding claim 45 Ginter et al (See Abstract, Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) shows wherein each content component comprises a media presentation.

33. Regarding claim 47, Kadyk ('111) discloses the content packet server according to claim 46 further comprising a transmitter for transferring the content packet to a distribution server for downloading to a wireless device.(Column 4, lines 43-49; column 7, lines 43-column 8 line 3) Examiner notes that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform(MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

34. Regarding claim 48, Kadyk ('111) discloses the content packet server being further configured to insert an installation application for installing the content packet to the wireless communication device. (Column 9, lines 10-35; column 11, lines 17-33) Examiner notes that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

35. In regard to Claim 46-48 the features of information stored in memory are representative

of non-functional descriptive information and it has been held such information will not

distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir.

1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir.

1994); MPEP 2106.01).

Conclusion

36. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHN M. WINTER whose telephone number is

(571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685